

Serial No. 09/868,515

SCHELBERGER ET AL.

PF ++49651

application as filed recites the structure of compound Id, and moreover claim 1 as originally filed disclosed compound Id. However, Applicant hereby amends claim 12 to include the limitations of claim 25 which now recite compounds Ia, Ib and Ic.

The Examiner also rejected claims 12-23 and 26-38 under 35 USC §112 for lack of enablement, in particular with respect to compound Id. Claim 12 has been amended to recite compounds Ia, Ib and Ic. The Examiner has stated that Dr. Eberhard Ammermann's declaration² is fully persuasive as to compounds Ia, Ib, and Ic in combination with compound IIa. Applicant agrees that the declaration and Examples disclosed in the application show a synergistic effect in the combination of said compounds. Therefore favorable action is solicited.

The Examiner also rejected claims 12-38 under 35 USC §103(a) as being unpatentable over Schwalge et al. (WO 97/06681) and Kasahara et al. (WO 96/19442). The Examiner has argued that Schwalge et al. discloses a morpholine compound useful as a fungicidal compound and that Kasahara et al. discloses oxime derivatives useful as a fungicidal compound and that it would have been obvious to combine such compounds for controlling harmful fungi.

According to §103, in order to establish a prima facie case of obviousness, there must be (1) some suggestion or motivation to modify the references, (2) reasonable expectation of success and (3) the prior art reference must teach or suggest all of the claim limitations.³

The references cited herein do not teach or suggest all the claim limitations. Claim 1 recites, inter alia, the combination of compound I and compound II in a synergistically effective amount. The references, while mentioning fungicidal mixtures, do not teach or suggest the combination of compounds Ia, Ib, or Ic with compound of formula II in a synergistically effective amount or that such would have such synergistic effect.

Furthermore such synergistic effect is in itself evidence of non-obviousness.⁴ The Examples along with Dr. Ammerman's declaration demonstrate an effect that is greater

² Declaration of Dr. Eberhard Ammermann filed November 2001

³ See MPEP §2143

⁴ Manual of Patent Examining Procedure §716.02(a)

Serial No. 09/868,515

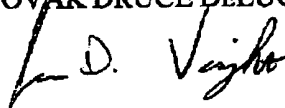
SCHELBERGER ET AL.

PF ++49651

than the sum of each component individually, or than would be expected in combination⁵. As can be seen from the Examples⁶ and Dr. Ammerman's declaration,⁷ the observed efficacy of the active compound compositions were much higher than the expected efficacy as derived by Colby's formula. For example, in the declaration the combination of Ia and IIa, at .25 and .06 ppm respectively, resulted in an observed degree of action of 100, whereas the expected degree of action as derived by the Colby formula was 84. Such unexpected results demonstrate the synergistic effects of the claimed combination. Therefore the Applicant respectfully requests that the §103 rejection be withdrawn.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees, to Deposit Account No. 14.437. Please credit any excess fees to such deposit account.

Respectfully submitted,
NOVAK DRUCE DELUCA & QUIGG, LLP



Jason D. Voight
Reg. No. 42,205

JDV/JWB

1300 Eye Street, N.W.
400 East Tower
Washington, D.C. 2000

⁵ See id.

⁶ Application pg. 17, table 2

⁷ Declaration pg. 4